

REMARKS/ARGUMENTS

Claims 1-18 are in the case and subject to a restriction requirement. By the foregoing amendment, claims 1 and 12 are cancelled and claims 19-20 are added. Claims 2-4, 6-7, 13-14, and 17 are amended to conform the claims to newly added claims 19 and 20. Support for claims 19 and 20 can be found in the cancelled claims 1 and 12, in the Figs. 1A and 4 and in the specification on page 5, lines 21-24 and page 6 lines 8-15. No new matter is entered into the case by the amendment.

According to the examiner, the application contains the following inventions which are said to be patentably distinct:

Group I. Claims 1-7 and 12-18 drawn to a process, classified in class 451, subclass 38.

Group II. Claims 8-11 drawn to a product, classified in class 347, subclass 47.

In response to the restriction requirement a provisional election was made by Applicants' attorney on August 21, 2002, to prosecute the Group I Claims, Claims 1-7 and 12-18. This election was made solely for the purpose of advancing prosecution in the case and was made with traverse. Applicants hereby confirm the election to prosecute the Group I claims.

In the office action, the drawings were objected to under 37 C.F.R. §1.83(a). Claims 1 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,402,301 to Powers et al., in view of U.S. Patent No. 5,454,928 to Rogers et al. and as further evidenced by U.S. Patent No. 5,105,588 to Verley et al. and U.S. Patent No. 6,045,214 to Murthy et al. Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over the '301 patent to Powers et al. in view of the '928 patent to Rogers et al., the '588 patent to Verley et al., the '214 patent to Murthy et al., and further in view of U.S. Patent No. 4,950,583 to Brewer et al. Claims 2-3, 5, and 7-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '301 patent to Powers et al. in view of the '928 patent to Rogers et al., the '588 patent to Verley et al., the '214 patent to Murthy et al., the '583 patent to Brewer et al., and further in view of U.S. Patent No. 6,448,313 to Patel. Claim 12 was rejected under 35

U.S.C. §103(a) as being unpatentable over the '301 patent to Powers et al. in view of the '928 patent to Rogers et al., the '588 patent to Verley et al., the '214 patent to Murthy et al., and further in view of U.S. Patent No. 5,677,063 to Kamiyama et al. and U.S. Patent No. 6,409,312 to Mrvos et al. Claims 13-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '301 patent to Powers et al. in view of the '928 patent to Rogers et al., the '588 patent to Verley et al., the '214 patent to Murthy et al., the '063 patent to Kamiyama et al., and the '312 patent to Mrvos et al., and further in view of the '313 patent to Patel. Claims 17-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over the '301 patent to Powers et al. in view of the '928 patent to Rogers et al., the '588 patent to Verley et al., the '214 patent to Murthy et al., the '063 patent to Kamiyama et al., and the '312 patent to Mrvos et al.

The restriction requirement and rejections are respectfully traversed. Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

A. The Restriction Requirement Should be Withdrawn.

Applicants respectfully submit that the requirement to restrict the claims made in this case is improper. The claims as grouped by the examiner are sufficiently related that their respective classes and subclasses would be thoroughly cross-referenced, and essentially the same classes and subclasses would have to be reviewed regardless of which group was examined.

When searching the Group I claims for prior art relating to claims directed to a method for micromachining a silicon wafer, the examiner will undoubtedly have to search art related to silicon wafers containing the layers provided in the Group II claims (claims 8-11). Likewise, when searching the Group II claims for subject matter directed to silicon wafers containing protective layers, the examiner should search art relating to methods for applying protective layers to silicon wafers called for in the Group I claims.

It is therefore evident that examination of the Group I and Group II claims in separate applications will result in duplication of effort since the same

classes and subclasses should be searched regardless of which claims are elected. Such duplication of effort is wasteful of Patent Office manpower and resources and it also needlessly increases the cost to the public in obtaining patent protection for closely related inventions or for applications which contain claims of overlapping scope.

Moreover, restriction is not "required" by 35 U.S.C. § 121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). The MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

The Examiner has not shown any serious burden if examination of all of the claims is conducted at one time. Applicants therefore urge the examiner to reconsider this matter, withdraw the restriction requirement, and proceed with examination of Claims 1-18 in this application.

B. Claims 2-7, 13-18, and 19-20 Do Not Contain Matter Not Shown in the Drawings.

By the foregoing amendment, matter complained of as not being shown in the drawings has been removed from the claims. Accordingly, it is believed the amendment overcomes the objection to the drawings.

C. Claims 2-7, 13-18, and 19-20 Are Patentably Distinguished Over the Cited References.

In all of the §103(a) rejections set forth above, U.S. Patent No. 6,402,301 to Powers et al. is cited as the primary reference. However, as evidenced by the attached declaration of one of the inventors, Brian C. Hart, the invention was conceived of prior to the filing date of the '301 patent and was diligently reduced to practice. Having thus removed the primary reference as prior art in all of the

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Docket No. 2001-0128.00
(56202.US/4665.0)

rejections, it is submitted that the rejections of claims 2-7, 13-18, and 19-20 are untenable and should be withdrawn.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

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*** CERTIFICATE OF FIRST CLASS MAILING ***

I hereby certify that this paper is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231,

Date: 12/26/02

David E. LaRose
David E. LaRose, Reg. No. 34,369

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 2 (amended). The method of Claim [1] 19 wherein the protective material comprises a water-soluble polyacrylamide.

Claim 3. (amended) The method of Claim [1] 19 wherein the protective material is derived from a polyacrylamide material and the protective material is applied to a silane adhesion promoter layer as the first layer.

Claim 4 (amended). The method of Claim [1] 19 comprising applying a silane adhesion promoter material to the first surface of the wafer before applying the protective material to the wafer.

Claim 6 (amended). The method of Claim [1] 19 wherein [grit blasting] slot forming step is conducted using a grit blast material selected from alumina and silicon carbide.

Claim 7 (amended). The method of Claim [1] 19 wherein the first [protective] layer comprises a silane adhesion promoter layer and a photoresist layer and the protective layer comprises a polyacrylamide layer, further comprising substantially removing the polyacrylamide layer subsequent to [grit blasting] the slot forming step to provide a wafer containing the silane layer and the photoresist layer.

Claim 13 (amended). The method of Claim [12] 20 wherein the grit blasting step is conducted using a grit blast material selected from alumina and silicon carbide.

Claim 14 (amended). The method of Claim [12] 20 wherein the first layer comprises a photoresist layer and the second layer comprises a polyacrylamide layer applied to the photoresist layer.

Claim 17 (amended). The method of Claim [12] 20 wherein the first layer comprises a photoresist material having a thickness ranging from about 1 to about 10 microns.



Attorney Docket No. 2001-0128.00
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brian C. Hart et al.

Application No.: 09/929,849

Filing Date: August 14, 2001

Confirmation No.: 9848

Title: METHOD FOR MAKING INKJET PRINTHEADS

Examiner: R. P. Culbert

Group Art Unit: 1763

DECLARATION OF BRIAN C. HART UNDER 37 C.F.R. §1.131

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

I, Brian C. Hart, declare that:

1. I am over 18 years of age and one of the named co-inventors in the U.S. patent application identified above and I make this declaration based upon personal knowledge of the facts stated herein.

2. I am currently employed by the assignee, Lexmark International, Inc., in Lexington, Kentucky as a Development Engineer.

3. I graduated in 1996 from the University of Illinois at Urbana-Champaign with a B.S. in Ceramic Engineering and obtained an M.S. degree in Materials Science and Engineering from the University of Illinois in 1998.

4. I am intimately familiar with the above referenced application, the office action dated October 29, 2002, and, in particular, with U.S. Patent No. 6,402,301 to Powers et al. relating to ink jet printheads and methods for making printheads.

5. Prior to October 27, 2000, the invention was conceived as described and claimed in Claims 1-18 of the above reference application in this country as evidenced in the accompanying Invention Disclosure No. 0239 signed by me, Shauna M. Leis and Gary R. Williams, and witnessed by G. Patil and Colin Maher. All of the dates redacted from the invention disclosure are before October 27, 2000, the filing date of the '301 patent.

6. We have been diligent in pursuing the invention up to and including the filing date of this application, namely August 14, 2001.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 12/20/02

Brian C. Hart
Brian C. Hart